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**REMARKS**

Claims 1-8, 10-12, 14-19, 23-27 and 39-47 are currently pending in the subject application and are presently under consideration. Claims 1-8, 10-12, 14-19, 23-25, 39-46 have been amended herein. A marked-up version of all claims showing changes made can be found at pages 6-14 of this Reply. In addition, the specification has been amended as indicated at pages 2-5 to correct minor typographical errors.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claim 25 Under 35 U.S.C. § 112**

Claim 25 stands rejected under 35 U.S.C. § 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; that is “, wherein the associating comprises freely associating...”, the term “associating” needs to be defined. Withdrawal of this rejection is requested for at least the following reasons.

The written description portion of the invention describes in full, clear, concise, and exact terms what is meant by “associated” (and similarly “associating”). The terms “associated” and “associating” are defined or described numerous times in the specification depending on which component of the invention the portable terminal interfaces. (See pg. 12, ln. 12-17; pg. 20, ln. 16-18; pg. 21, ln. 7-10; pg. 24, ln. 4-9). For example, when the portable terminal is associated with the kiosk in the shopping establishment, “by “associated” it is meant that the kiosk electrical or optical interface 28 is located so as to communicate with a two-way data interface of the portable terminal...when the portable terminal is placed in the portable terminal-receiving station 26.” (See pg. 20, ln. 16-18). Similarly, when the portable terminal is associated with the home terminal, “by “associated” it is meant that the data interface 34 is so located so as to interface with a corresponding two-way data interface of a portable terminal-receiving station 32 of the home cradle 30.” (See pg. 21, ln. 7-10). Accordingly, this rejection should be withdrawn.

**II. Rejection of Claims 1, 39, 41, and 46 Under 35 U.S.C. § 103(a)**

Claims 1, 39, 41, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), and further in

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view of Fernandez, *et al.* (U.S. 6,697,103). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither O'Hagan, *et al.*, Kolawa, *et al.*, nor Fernandez, *et al.* alone or in combination, disclose, teach or suggest all the features recited by the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also ***providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done***. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993) (emphasis added).

O'Hagan, *et al.* fails to disclose, teach, or suggest "the at least one shopping terminal is a ***bar code storage device***," or "one or more ***proximity sensors that monitors customer activity*** in product sales areas in the shopping establishment...that ***generates a theft condition*** upon expiration of a time period that starts after receipt of a signal from the proximity sensor," as recited by independent claim 1. On the contrary, when a barcode is scanned the CIT transmits a link request to launch a bar code program at the host, wherein the host computer stores the bar code and looks up the price and description corresponding to the UPC code in the price and description databases, then returns a link to a page the host program generated based upon the scanned product. (See col. 16, ln. 44-61). Bar codes may be stored in several lists maintained on the host computer, but not the CIT. Therefore, the CIT is not a bar code storage device.

In the Office Action dated February 1, 2005, the Examiner contends "that merely adding a barcode storage device and a proximity sensor to the claimed system [does] not make claimed

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subject matter not obvious to one of ordinary skill in the art at the time of the invention because a system's configurations comprise structural components or structural modules that [make] up said claimed system, and the added components are already old and well-known, it is just a matter of integrating known components together – (see *In re Murray*; *In re Zabel et al.* wherein above barcode storage device and a proximity sensor would be integrated into O'Hagan et al.'s system – There is also a requirement that the integration of those claimed components involve more than mere mechanical skill.)” (See Office Action, Page 2-3).

Assuming *arguendo* that the barcode storage device and proximity sensor of the claimed invention are known components, neither case cited by the Examiner stands today for the proposition that integrating known components cannot be non-obvious or that known components can be integrated into a reference by the Examiner without some teaching or suggestion in the reference itself simply because the component is already known. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. *Diamond v. Diehr*, 450 U.S. 175, 189 (1981). Moreover, the Federal Circuit has consistently held that

**...‘virtually all [inventions] are combinations of old elements.’** Therefore an examiner may often find every element of a claimed invention in the prior art. ***If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.*** Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. ***Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’*** *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (citations omitted).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ2d 1780, 1783-1784 (Fed. Cir. 1992). Further, contrary to the Examiner's contention, there is no requirement that the integration of known components requires more than mere mechanical skill to escape a finding of obviousness. A requirement for “synergism” or “synergistic effect” (e.g., “more than mere mechanical skill”) is

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nowhere found in the statute, 35 U.S.C. (*See Stratoflex, Inc. v. Aero-quip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983).

The Examiner contends, "Kowala's reference (as a primary reference) is still proper for a "system" claim because it would be obvious to one with ordinary skill in the art at the time of invention to utilize/integrate available electronic components/devices (i.e., a proximity sensor, and a computer instruction to alarm/notice a (theft) condition immediately or after a predetermined period)." (*See Office Action, Page 3*) (emphasis in original). Here, the Examiner is stating that availability is the test for obviousness when there is no such test. Again, the mere fact that those disclosures *can* be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. There is no such suggestion for the combination found in the cited references.

The Examiner states, O'Hagan, *et al.* does not expressly disclose that "a centrally server/controller for communicating with said terminal/computer system and said remote terminal via a network". However, Kolawa, *et al.* obviously teaches communication can go through an intermediate server, then to a store's terminal. (*See Office Action, Page 6*). Again, this is an improper combination of references. The suggestion to combine the references must not require substantial reconstruction or redesign of the references to arrive at the claimed invention. *In re Ratti*, 123 USPQ 349 (CCPA 1959). Here, to modify O'Hagan, *et al.* with the teachings of Kolawa, *et al.* would require substantial reconstruction or redesign.

The Examiner further states, "O'Hagan, *et al.* and Kolawa, *et al.* did not disclose about generating an alarm signal (i.e., a theft condition) after a period of receiving a camera's signal." But that, "Fernandez, *et al.* suggest that idea using proximity sensor 44 for sensing physical objects." However, Fernandez, *et al.* relates to a method of tracking a small number of extremely important objects, especially along known paths. Furthermore, to track the items, general navigational functionality such as radio triangulation functionality relative to local radio signal sources, or GPS receiver relative to satellite signaling sources, for determining location of target unit 4 must be implemented into the locator unit(s) at enormous cost. There is no motivation to implement these features in the system of O'Hagan, *et al.* where thousands of products are on the shelves, none of which may be important, and none of which have known paths. For example, the system of Fernandez, *et al.* cannot know when or why a customer will pick up a product from a shelf, and it cannot know where the customer will go after doing so, or

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even if the product will be returned back to the shelf. Instead, Fernandez, *et al.* must track all products whether or not they are on the shelf, and even those already scanned for purchase by the customer and moving in unknown paths throughout the store, and it could not distinguish between "valid" product movement and "invalid" movement (*i.e.*, theft). There is no motivation to combine Fernandez, *et al.* with O'Hagan, *et al.* or Kolawa, *et al.* Moreover, it is apparent that the combination of these three references would require substantial reconstruction or redesign of the references to arrive at a system that still fails to teach or suggest the claimed invention.

For at least the aforementioned reasons, the Examiner has failed to establish a *prima facie* case for obviousness. Accordingly, this rejection must be withdrawn.

### **III. Rejection of Claim 7 Under 35 U.S.C. § 103(a)**

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), and further in view of purported available old and well-known tools for computer's application. This rejection should be withdrawn for at least the following reasons.

Claim 7 depends from claim 1. Claim 1 is allowable for at least the aforementioned reasons. By virtue of its dependency, claim 7 includes all the features of claim 1. Therefore, claim 7 is allowable for at least the same reasons as claim 1.

Claim 7 recites a *shopping terminal* comprises means for converting any currency amount to and from a corresponding Euro amount. The Examiner asserts, "It is old and well known that any computer with a look-up table (LUT)... and a calculating function storing in its hard drive & its microprocessor would do the conversions claimed." Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of her position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained. Moreover, assuming *arguendo*, that it is known that computers can perform conversions, that does not teach or suggest a shopping terminal that comprises a conversion means. Accordingly, this rejection should be withdrawn for at least this additional reason.

### **IV. Rejection of Claim 8 Under 35 U.S.C. § 103(a)**

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), and further in view of

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Fernandez, *et al.* (U.S. 6,697,103). This rejection should be withdrawn for at least the following reasons.

Claim 8 depends from claim 1. Fernandez, *et al.* fails to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 8 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, and Fernandez, *et al.*

The Examiner "...submits that it is old and well-known that a computer using a modem for communication with secured lines because artisans in the art would recognize that it needs a secured and critical line in transactions relating to money; and silent communications were known to be available options..." Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of her position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained.

Furthermore, the asserted fact that computers utilize a modem for communications alone or in combination with the cited references does not disclose, teach, or suggest at least one *shopping terminal is coupled to a telephone line* and the shopping terminal comprises means for providing secure and silent communications *to transmit data to and from the shopping terminal without notifying or disturbing a user*, as recited by claim 8.

For at least the aforementioned reasons, this rejection should be withdrawn.

**V. Rejection of Claim 14 Under 35 U.S.C. § 103(a)**

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), and further in view of Fernandez, *et al.* (U.S. 6,697,103). This rejection should be withdrawn for at least the following reason:

Claim 14 depends from claim 1. Fernandez, *et al.* fails to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 14 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, and Fernandez, *et al.* Therefore, claim 14 is allowable for at least the same reasons as claim 1. Accordingly, this rejection should be withdrawn.

**VI. Rejection of Claim 19 Under 35 U.S.C. § 103(a)**

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Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Fernandez, *et al.* (U.S. 6,697,103), and further in view of Wren (U.S. 6,055,514). This rejection should be withdrawn for at least the following reasons.

Claim 19 depends from claim 1. Fernandez, *et al.* and Wren fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 19 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.* and Wren. Therefore, claim 19 is allowable for at least the same reasons as claim 1.

Additionally, the Examiner has failed to provide proper motivation for the combination of references. In particular, the Examiner asserts that it would be obvious to combine the configurations of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, and Wren, because "...artisans would recognize that means for biometric verifying a customer identification using finger-prints are very distinguishable in a money transaction." The assertion that biometrics are distinguishable does not motivate the combination of references as suggested.

For at least the aforementioned reasons, this rejection should be withdrawn.

#### **VII. Rejection of Claims 2, 40 and 43 Under 35 U.S.C. §103(a)**

Claims 2, 40, and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Fernandez, *et al.* (U.S. 6,697,103), and further in view of Ruppert, *et al.* (U.S. 5,424,524). This rejection should be withdrawn for at least the following reason.

Claims 2 and 40 depend either directly or indirectly from claim 1. Fernandez, *et al.* and Ruppert, *et al.* fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claims 2 and 40 are not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.* and Ruppert, *et al.* Therefore, claims 2 and 40 are allowable for at least the same reasons as claim 1.

Furthermore, the cited references alone or in combination fail to disclose, teach, or suggest *each and every claim feature* of the subject invention as required to establish a *prima facie* case of obviousness under § 103. In particular, claim 2 recites the portable terminal comprising an *elongated pen-shaped housing* having an end with an optically transparent passage there through that *enables bar codes to be read*. The Examiner concedes that O'Hagan,

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*et al.*, Kolawa, *et al.*, Fernandez, *et al.* fail to disclose the claimed features. However, the Examiner asserts that the claimed features would be obvious in light of Ruppert, *et al.* Ruppert, *et al.* discloses a light pen associated with a personal scanner. The light pen is operable to interact with the display screen of the scanner to receive user input. The light pen is not operable to enable bar codes to be read. Accordingly, the features of claim 2 would not be obvious.

The cited references alone or in combination also fail to disclose, teach, or suggest at least one shopping terminal comprises a scanning system comprising a *wearable computer processor and a wearable scanning device*, as recited by claim 43. The Examiner contends that Ruppert, *et al.* teaches a wearable computer processor and scanning device, because it discloses a lightweight and portable bar code scanner. However, the mere disclosure that a barcode scanner is lightweight and portable alone does not teach or suggest a wearable computer processor and a wearable scanning device as recited. Lightweight and portable are relative terms that by themselves do not suggest that the elements they describe are wearable.

For at least the aforementioned reasons, this rejection should be withdrawn.

#### **VIII. Rejection of Claim 3 Under 35 U.S.C. §103(a)**

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Fernandez, *et al.* (U.S. 6,697,103), in view of Ruppert, *et al.* (U.S. 5,424,524), and further in view of Bianco (U.S. 5,047,614). This rejection should be withdrawn for at least the following reason.

Claim 3 depends from claim 1. Fernandez, *et al.*, Ruppert, *et al.* and Bianco fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 3 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, Ruppert, *et al.* and Bianco. Therefore, claim 3 is allowable for at least the same reasons as claim 1.

#### **IX. Rejection of Claim 4-6 Under 35 U.S.C. §103(a)**

Claims 4-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Fernandez, *et al.* (U.S. 6,697,103), in view of Ruppert, *et al.* (U.S. 5,424,524), and further in view of Bianco (U.S. 5,047,614). This rejection should be withdrawn for at least the following reason.



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Claims 4-6 depend indirectly from claim 1. Fernandez, *et al.*, Ruppert, *et al.*, and Bianco fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 4 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, Ruppert, *et al.*, and Bianco. Therefore, claims 4-6 are allowable for at least the same reasons as claim 1, and their allowance is respectfully requested.

**X. Rejection of Claim 10 Under 35 U.S.C. §103(a)**

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Ruppert, *et al.* (U.S. 5,424,524), and further in view of Fernandez, *et al.* (U.S. 6,697,103). This rejection should be withdrawn for at least the following reason.

Claim 10 depends from claim 1. Fernandez, *et al.* and Ruppert, *et al.* fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 10 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, and Ruppert, *et al.* Therefore, claim 10 is allowable for at least the same reasons as claim 1.

**XI. Rejection of Claims 11 and 43 Under 35 U.S.C. §103(a)**

Claims 11 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Ruppert, *et al.* (U.S. 5,424,524), and further in view of Fernandez, *et al.* (U.S. 6,697,103). This rejection should be withdrawn for at least the following reasons.

Claim 11 depends from claim 1. Fernandez, *et al.* and Ruppert, *et al.* fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Thus, claim 11 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, and Ruppert, *et al.* Therefore, claim 11 is allowable for at least the same reasons as claim 1.

As per claim 43, the cited references alone or in combination also fail to disclose, teach, or suggest at least one shopping terminal comprises a scanning system comprising a *wearable computer processor and a wearable scanning device*, as recited. The Examiner contends that Ruppert, *et al.* teaches a wearable computer processor and scanning device, because it discloses a lightweight and portable bar code scanner. However, the mere disclose that a barcode scanner is lightweight and portable alone does not teach or suggest a wearable computer processor and a

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wearable scanning device as recited. Lightweight and portable are relative adjectives that by themselves do not suggest that the elements they describe are wearable.

**XII. Rejection of Claims 12 and 44 Under 35 U.S.C. §103(a)**

Claims 12 and 44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), and further in view of Fernandez, *et al.* (U.S. 6,697,103). This rejection should be withdrawn for at least the following reason.

Claim 12 depends indirectly from claim 1. Claim 1 is allowable for at least the aforementioned reasons. By virtue of its dependency, claim 12 includes all the features of claim 1. Therefore, claim 12 is allowable for at least the same reasons as claim 1.

Claim 44 depends from independent claim 43. Claim 43 is allowable for at least the aforementioned reasons. By virtue of its dependency, claim 44 is allowable for at least the same reasons as claim 43.

Accordingly, the subject rejection should be withdrawn.

**XIII. Rejection of Claims 15-18 and 45 Under 35 U.S.C. §103(a)**

Claims 15-18 and 45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Ruppert, *et al.* (U.S. 5,424,524), and further in view of Fernandez, *et al.* (U.S. 6,697,103). This rejection should be withdrawn for at least the following reasons.

Claims 15-18 depend directly or indirectly from claim 1. Fernandez, *et al.* and Ruppert, *et al.* fail to make up for the deficiencies of O'Hagan, *et al.* and Kolawa, *et al.* with respect to claim 1. Hence, claims 15-18 are not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, and Ruppert, *et al.* Therefore, claims 15-18 are allowable for at least the same reasons as claim 1, and their allowance is respectfully requested.

As with claim 1, independent claim 45 recites, "...the controller including at least one computer executable instruction that generates a theft condition upon expiration of a time period that starts after receipt of a signal from the proximity sensor". None of the cited references alone or in combination disclose, teach, or suggest this feature. Thus, claim 45 is not made obvious by the combination of O'Hagan, *et al.*, Kolawa, *et al.*, Fernandez, *et al.*, and Ruppert, *et al.*

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For at least the aforementioned reasons, claims 15-18 and 45 are allowable. Accordingly, the rejection thereto should be withdrawn.

**XIV. Rejection of Claim 23 Under 35 U.S.C. §103(a)**

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* and purported the old and well-known the United Parcel Service (UPS) practices

The Examiner asserts that the follow steps are old and well known:

- associating a terminal with a server and a user/customer (by using a scanner to input related data – e.g., delivering time at a customer's address, the scanner is a means to do an association);
- scanning an item using a scanner at a delivery address;
- returning the scanner to the terminal receptacle (e.g., for battery charging, or for waiting of another usage;
- generating a receipt corresponding to a scanned item (e.g., a portable scanner couples to a computer and a printer); and
- distributing/purchasing a scanned item at a check-out station (e.g., at IKEA furniture stores, customers performed such step – therefore, the issue is just automation old manual steps in this claim – see in re Venner).

Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of his position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained.

Furthermore, neither Kolawa, *et al.* nor the purportedly old and well-known United Parcel Service (UPS) practices disclose, teach, or suggest *triggering a theft condition after failure to detect a product scan within a predetermined period of time after activation of one or more sensors*. Accordingly, this rejection should be withdrawn.

**XV. Rejection of Claim 24 Under 35 U.S.C. §103(a)**

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* and Official Notice of purported old and well-known steps.

The Examiner asserts that the following steps are old and well-known:

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- checking-in by a customer (sign-in for services after arrival at a spot – e.g., in Lens Crafter stores, or sign-up for a services at a public library);
- authorizing a terminal/computer for use (at a public library); and
- obtaining an authorized terminal from its location (e.g., a librarian assigns an authorized computer to a patron)

Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of his position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained.

Furthermore, claim 24 is allowable for at least the same reasons as claim 23 from which it depends. This rejection should be withdrawn.

**XVI. Rejection of Claim 25 Under 35 U.S.C. §103(a)**

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* and purported old and well-known steps. This rejection should be withdrawn for at least the following reasons.

The Examiner submits that a step of associating a terminal with a network is old and well-known (e.g., a library patron registers to surf the web). Applicants respectfully traverse the aforementioned well-known statement and request that the Examiner cite a reference in support of his position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained.

Additionally, claim 25 is allowable for at least the same reasons as claim 23 from which it depends. This rejection should be withdrawn.

**XVII. Rejection of Claim 26 Under 35 U.S.C. §103(a)**

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* and purported old and well-known steps. This rejection should be withdrawn for at least the following reasons.

The Examiner submits that it is old and well known for a customer to practice the following steps:

- generating a list from a remote location (e.g., customer orders from bestbuy.com using a generated shopping list – this step can also be done manually);

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- forwarding said list to a controller/server (e.g., customer orders from bestbuy.com input a shopping list via a computer's keyboard);
- generating a picking list at the server/controller corresponding to items identified in the shopping list (e.g., generating a print-out for picking up items at bestbuy warehouse); and
- collecting the items identified in the picking list for check-out/delivery (e.g., put items in said picking list in one box to scan barcodes on them for obtaining prices of ordered items.

Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of his position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained.

Furthermore, claim 26 is allowable for at least the same reasons as claim 23 from which it depends. This rejection should be withdrawn.

**XVIII. Rejection of Claim 27 Under 35 U.S.C. §103(a)**

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kolawa, *et al.* and purported old and well-known steps. This rejection should be withdrawn for at least the following reasons.

Examiner submits that it is old and well known for a customer to do the following steps:

- generating a (shopping) list (e.g., customer orders from bestbuy.com using a shopping list);
- forwarding said list to a server/controller (e.g., bestbuy.com practice);
- generating a picking list at the server/controller (corresponding to items identified in the shopping list) this step is a MUST in order to do business;
- assigning a barcode to the picking list (e.g., this step has been done for UPS package; moreover, it can be a designer's choice to easily recognize different orders);
- printing a label showing the picking list ID barcode (e.g., this step has been done for UPS packages);
- scanning items corresponding to said picking list (e.g., checking out a circuit city stores); and

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collecting scanned items for check-out (this step is a MUST in order to do business; e.g., amazon.com business practice).

Applicants respectfully traverse the aforementioned well-known statements and request that the Examiner cite a reference in support of his position pursuant to MPEP § 2144.03 if the rejection of this claim is to be maintained.

In addition, claim 27 is allowable for at least the same reasons as claim 23 from which it depends. This rejection should be withdrawn.

**XIX. Rejection of Claim 43 Under 35 U.S.C. §103(a)**

Claim 43 stands rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Fernandez, *et al.* (U.S. 6,697,103), and further in view of Ruppert, *et al.* (U.S. 5,424,524). This rejection should be withdrawn for at least the following reason.

The cited references alone or in combination also fail to disclose, teach or suggest at least one shopping terminal comprises a scanning system comprising a *wearable computer processor and a wearable scanning device*, as recited by claim 43. The Examiner contends that Ruppert, *et al.* teaches a wearable computer processor and scanning device, because it discloses a lightweight and portable bar code scanner. However, the mere fact that Ruppert, *et al.* discloses that a barcode scanner is lightweight and portable alone does not teach or suggest a wearable computer processor and a wearable scanning device as recited. Lightweight and portable are relative terms that by themselves do not suggest that the elements they describe are wearable. Accordingly, this rejection should be withdrawn.

**XX. Rejection of Claims 42 and 47 Under 35 U.S.C. §103(a)**

Claims 42 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hagan, *et al.* (U.S. 6,314,406), in view of Kolawa, *et al.* (U.S. 6,236,974), in view of Fernandez, *et al.* (U.S. 6,697,103), and further in view of Stevens (U.S. 5,496,540). This rejection should be withdrawn for at least the following reason.

Claim 42 and 47 are allowable for at least the same reasons provided *supra* with respect to claims 1 and 23 from which they respectively depend. Stevens fails make up for the

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deficiencies of O'Hagan, *et al.*, Kolawa, *et al.*, and Fernandez, *et al.* with respect to independent claims 1 and 23.

Moreover, the cited references fail to disclose, teach, or suggest each and every feature of claims 42 and 47. In particular, none of the references alone or in combination discloses or teaches, "the controller activating one of an alarm and a camera *upon receipt of a theft condition*," as recited by claims 42 and 47.

For at least the aforementioned reason, this rejection should be withdrawn.

### CONCLUSION


The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [SYMBP128USC].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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